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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,649	05/31/2001	Michael Anthony Sijacic	06502.0339	7981

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EXAMINER

HAVAN, THU THAO

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/867,649

Applicant(s)

SIJACIC ET AL.

Examiner

Thu Thao Havan

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-45 and 47-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-45, and 47-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claims 1-7, 9-45, and 47-59 are pending. This action is in response to the remarks received July 17, 2007.

Response to Arguments

The rejection of claims 1-7, 9-45, and 47-59 under 35 U.S.C. 102(e) as being unpatentable by Ludwig et al. (US 2003/0167229) is maintained.

Upon a closer examination, Applicant's arguments filed July 17, 2007 have been fully considered but they are not persuasive.

In response to the arguments concerning the previously rejected claims the following comments are made:

Applicant alleges that the prior art made of record fails to teach a tag that indicates a response format associated with the requesting entity. The examiner disagrees with applicant's representative since Ludwig teaches a tag that indicates a response format associated with the requesting entity (para. 0089, 0112-0113, 0022, 0027, 0031, 0034, 0036, 0039, 0044, and 0051). As Applicant defines in the specification, a tag is "the type of corresponding response message required" (abstract). Thus Ludwig discloses a tag when he discloses a mark. He discloses mark as closing all invoices that are selected. The system may display to the user a confirmation message before the invoices are closed, e.g., "You have selected 24 invoices to close. Are you sure you want to close these invoices?" The system may not permit closed invoices to appear in any active

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queries. The system may subject invoices that are marked as closed to host archiving and purging criteria. In addition, the biller system permits a user to mark an invoice as closed by selecting desired invoices and clicking on the "Paid through another source" button. For example, "Close" may cause the system to mark as closed all invoices that are selected. Another example from Ludwig is an ordered listbox of fields marked for export with two buttons for moving fields between listboxes; up and down buttons may allow the field export order to be changed); and file formats (a listbox that allows the file format to be selected.

With regards to the claims rejected as taught by Ludwig, the examiner would like to point out that the reference teaches the claimed limitations and thus provides adequate support for the claimed limitations. Therefore, the examiner maintains that Ludwig taught the claimed limitations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9-45, and 47-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Ludwig et al. (US 2003/0167229).

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Re claim 1, Ludwig teaches a method for processing requests for information in an electronic invoice presentment and payment system including at least a requesting entity and a server system interconnected by a network (abstract; fig.1), the method comprising:

receiving a request configured in a first format at the server system, wherein the request includes a tag that indicates a response format associated with the requesting entity (para. 0089, 0112-0113, 0022, 0031, 0034, 0039, 0044, and 0051; Ludwig discloses mark as corresponding to tag. He discloses the predefined format is an extensible markup language (XML) schema and the data files are XML messages. He further discloses the template settings area may contain the following exemplary controls (which the system may be adapted to store as global information on the database): fields and export order (may contain a listbox of the available invoice fields and an ordered listbox of fields *marked* for export with two buttons for moving fields between listboxes; up and down buttons may allow the field export order to be changed); and file formats (a listbox that allows the file format to be selected);

generating a response associated with the request (para. 0032, 0054, 0068, and 0072; Ludwig generates response by email notices);

transforming the response to the response format based on the tag (para. 0027 and 0036; Ludwig discloses the step of converting the invoice file from one format to another format base on the response); and

making the transformed response available to the requesting entity (para. 0086; Ludwig displays the requesting entity by allowing users to edit and modify current invoice).

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Re claims **2** and **40**, Ludwig teaches first format and the response format are identical (para. 0032, 0121, and 0125; Ludwig teaches identical functions).

Re claims **3** and **41**, Ludwig teaches request was initiated by the requesting entity through the network (para. 0049, 0054, and 0072; figs. 1-2; Ludwig discloses transaction request in a network).

Re claims **4, 10, 12, 22, 26, 31, 35, 42, 50-51, and 57**, Ludwig teaches tag indicates a type of XSL conversion and transforming the format of the response comprises: using the type of XSL conversion indicated in the tag to convert the response to the first format (para. 0036; Ludwig discloses the step of converting invoice file from one format to another format).

Re claims **5, 9, 13-14, 43, and 47**, Ludwig teaches making request types available to the requesting entity; receiving a selection of a request type from the requesting entity; and generating the request configured in the first format based on the selection and the requesting entity (figs. 3-5; Ludwig illustrates the steps in making request by messages and invoice responses).

Re claims **6, 15, 21, 24-25, 29-30, 36, 44, 48, 53, and 55-56**, Ludwig teaches determining whether the request is in XML format; and converting the request to a particular XML format in the event the request is not in XML format (para. 0005; fig. 2).

Re claims **7, 27, 32, 45, 52, and 58**, Ludwig teaches particular XML format is based on a type of the request (para. 0022-0024; fig. 3).

Re claims **11** and **28**, Ludwig teaches a method for processing a response message associated with a request message corresponding to a requesting entity in an electronic invoice presentment and payment system (para. 0022-0030), comprising:

receiving a response message in a first format (para. 0030; fig. 3; Ludwig discloses verify the format of XML messages);

converting the response message to a second format based on an indicator included in the request message (para. 0027-0030 and 0036; Ludwig discloses the step of converting the invoice file from one format to another format base on the response); and

sending the converted response message to the requesting entity such that the second format is the same format as that of the request message (para. 0027, 0032, 0036; Ludwig sending e-mail notices of the invoices to one or more payer systems in relation to XML formatted message).

Re claim **16** and **23**, Ludwig teaches an electronic invoice presentment and payment system for processing request messages (para. 0022-0030; abstract; fig. 1), comprising:

a requesting entity for generating a first request in a first format (para. 0032, 0054, 0068, and 0072; Ludwig generates response by email notices);

a web server for receiving the first request and generating a first request message in a second format based on the first request (para. 0027-0030 and 0036; figs. 1-2); and

a servlet for receiving the first request message, determining a format for a response message based on an indicator included in the first request message, validating the first request message, requesting data from a server process based on the first request message, receiving response data from the server process, converting the response data into a response message in the second format (para. 0020-0025, 0027(validating), 0032(convert), 0051; fig. 1);

transforming the response message to the first format based on the determined format for the response message (para. 0027 and 0036; Ludwig discloses the step of converting the invoice file from one format to another format base on the response).

Re claim 17, Ludwig teaches servlet operates within a billing manager configured to manage electronic invoice presentment and payment operations associated with the requesting entity (para. 0072, 0085, 0089, and 0096; Ludwig discloses the billing system to mark an invoice with message request from system administrator).

Re claims 18-20, Ludwig teaches first format is one of XML, HTML and WML and the second format is XML (para. 0025-0026).

Re claims 33-34, 37-39, 49, 54, and 59, Ludwig teaches a method as claimed in claims 1, 11, 16, 23, and 28. Therefore the rationale applied in the rejection of claims 1, 11, 16, 23, and 28 applies herein.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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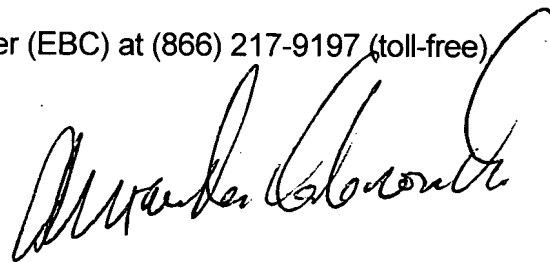
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached during her flexitime schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free)

TTH
9/23/2007



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